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EXAMINER

CORDRAY, DENNIS R

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1791

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Continuation Sheet

Continuation of 3. NOTE: The amended claims introduce new dependencies, which present new combinations not previously claimed, and which require further consideration and/or searching. In particular, Claim 14 now requires the hydrolyzed homo-or copolymer of Claim 9 to comprise vinylamine units, a limitation not previously required. Claim 15 depends from Claim 14, thus carries the same limitation. Claim 17 now depends from Claim 14, rather than from Claim 9, and carries the above-described new limitations not previously required. In addition, the new dependencies require consideration with regard to 35 U.S.C. 112 issues and support in the Specification.

Continuation of 10. The Declaration under 37 C.F.R. 1.132 has not been properly executed because it is not signed. Nevertheless, to the extent that the data described therein are deemed applicable to the instant claims, and in expectation of the submission of a properly executed Declaration, the following comments are made.

The data presented provide additional evidence that using a copolymer lying within the claimed range and added to the thick stock provides improved retention of white pitch particles in the stock. The Declarant states that a good result (but not necessarily a surprising or unobvious result) is achieved when the total number of pitch particles at a size above 15 micrometers has been reduced by more than 80% relative to the blank. Obtaining a result based on a specified reference point is a goal of an optimization process. The Declaration fails to demonstrate that obtaining a good result is equivalent of obtaining an unobvious or surprising result. In addition, one of ordinary

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skill in the art would have predicted that, in a more concentrated slurry (such as the thick stock), improved contact would be made between the vinylamine polymer and the pitch particles and better retention obtained.

In addition, the showing focuses on a copolymer of vinylamine and N-vinylformamide, and uses polymers having a molecular weight well above the claimed lower limit or well below the limit. The polymers are added in an amount of 400 g/t in the additional examples, but the basis for the addition is not known (e.g.-per ton of coated broke, per ton of stock, etc). Example 1 in the Specification states that the vinylamine polymer PVAm3 was added at 400 g/t based on the coated broke while Claim 8 specifies an addition amount based on dry paper stock. The claims embody polymers of any composition having any amount of vinylamine units, a degree of hydrolysis from 1-20% (hydrolysis of any species; N-vinylformamide is not necessarily the hydrolyzed species) having any molecular weight above one million and added in any amount to the stock. In addition, the claimed papermaking stock is not required to comprise coated broke or white pitch, but only interfering substances. The showing is not commensurate in scope with the claims.

Continuation of 11. Applicants arguments relate largely to the Declaration, which has been treated above. Regarding the arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Regarding Burkert et al, Auhorn references Burkert et al as teaching the process for making hydrolyzed polymers containing vinylamine units, thus combining Auhorn and Burkert et al is suggested by Auhorn.

The outstanding rejections over the cited prior art are maintained.

/Eric Hug/

Primary Examiner, Art Unit 1791